

Page 5, line 4, delete "greyish-brown accents", insert --greyed-green accents, RHS

B4 194D--.

line 16, after "RHS 86B", insert --, flower mid-vein RHS 63A--.

line 21, delete "11cm", insert --8.5 cm, depending on the cultivation of

B5 the cultivar--.

line 22, after "Color:", insert --RHS 132D--.

line 23, after "Form:", insert --Rounded--.

line 25, delete "Medium" and insert --average in comparison to the

B6 disease resistance level of traditional *Lily* cultivars--.

Page 6, line 2, after "Excellent", insert --; i.e., the average lasting period is at

B7 least 21 days, when cut and kept in a controlled climate in conformity with Dutch Auctions and Research Station standards--.

line 10, delete "White", insert --RHS 145D--.

line 12, after "Reddish brown", insert --RHS 180B--.

line 13, after "Green", insert -- RHS 145B--.

line 14, after "Dark-pink", insert --RHS 187A--.

### REMARKS

The examiner objects to the disclosure under 37 CFR § 1.163(a) and rejects the claim under 35 U.S.C. 112, first and second paragraphs, as being unsupported by a clear and complete botanical description, which distinguishes the cultivar from related known varieties. Favorable

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reconsideration and allowance of the application is requested in view of the foregoing amendments and the remarks which follow.

In order to expedite the examiner's review of this response, applicant will address each of the examiner's objections in the order they were discussed in the Official Action.

A. The specification has been amended at page 4, line 12, to quantify the term "vigorous". Additionally, pedicel form at page 5, line 23, has been defined.

B. The specification has been amended at page 4, line 14, to set forth the instant plant's internode length.

C. The specification has been amended at pages 4 to 6, to set forth the color designation for the bulb, accents on the bud, flower mid-vein, pedicel, and a color designation for each reproductive organ.

D. The specification has been amended at page 5, line 25, to clarify the recitation "medium" with respect to disease resistance.

E. The specification has been amended at page 6, line 2, to quantify the term "excellent" with respect to the instant plant's lasting quality.

#### **REJECTION OF THE CLAIM UNDER 35 U.S.C. § 102(d)**

Claim 1 is rejected under 35 U.S.C. § 102(d), as barred by the Plant Breeder's Rights enumerated on page 6, paragraph 1 of the Official Action. The examiner takes the position in the first Official Action that the Plant Breeder's Right is an "inventor's certificate" for the purposes

of 35 U.S.C. §102(d). The examiner therefore contends that the plant patent claim is barred because Plant Breeder's Rights, including a Netherlands Plant Breeder's Right was granted before the filing of a plant patent application and this Plant Breeder's Right is based on an application filed more than one before the plant patent application. Applicant respectfully traverses the rejection.

Plant Breeder's Rights, including a Netherlands Plant Breeder's Right, is not an inventor's certificate within the meaning of 35 U.S.C. § 102(d) and therefore the rejection should be withdrawn. As will be described in detail below, neither the legislation that included the inventor's certificate under 35 U.S.C. § 102(d), nor court decisions interpreting this legislation, provides support for viewing plant breeder's rights as an inventor's certificate that could give rise to forfeiture of rights under 35 U.S.C. § 102(d).

## **1. Historical Background: Inventor's Certificate Implementing Legislation**

### **a. The Soviet Cold War Origins**

Historically, and until the domestic implementation of the Stockholm Revision (1967) of the Paris Convention, the entirety of what is a "patent" in domestic and international understanding of the Paris Convention constituted Letters Patent that provide injunctive relief, i.e., the right to exclude others from their industrial property right under the local patent law. There had never been a hint or suggestion until the Stockholm Revision that an Inventor's Certificate could in any way, shape or form be considered a "patent" within the meaning of the international patent regime as globally codified through the Paris Convention.

The Inventor's Certificate was a Cold War manifestation of the Soviet economic system where a private party's monopoly was the antithesis of that system. The Soviet system was in a quandary. On the one hand, it provided an Inventor's Certificate to its nationals as a *substitute* for a patent, a kind of "gold medal" or "certificate" that could be used to honor inventive activity by citizens of the State but *without* the attributes of a patent, viz., without a patent monopoly

right. Clearly, an Inventor's Certificate could never have been considered a "patent", even though very patent-like in that it is obtained from a Patent Office and in many ways is just like a patent other than having an exclusionary right in private hands. So, it is highly understandable that the Inventor's Certificate was not given an international patent status, to the consternation of the Soviet system. This was a particular problem for Soviet patent rights in foreign systems because with the Inventor's Certificate falling outside the ambit of any international understanding of what constitutes a "patent", including that of the United States, it was clear that the Soviet national seeking an American, German or other foreign patent could not rely upon the Paris Convention priority right.

**b. Stockholm: Acknowledgement of the Soviet System**

The Stockholm Revision to the Paris Convention constituted a delicately balanced Cold War compromise that, *inter alia*, shifted stewardship of this treaty to the United Nations under the Stockholm-mandated World Intellectual Property Organization and also conceded a patent-like status to the "Inventor's Certificate" as a priority vehicle within the Paris Convention. The Stockholm amendments, however, did *not* recognize the Inventor's Certificate as a "patent" as there was no redefinition of the nature of the industrial property right in Art. 1 nor in the proscription against undue dilution of the exclusionary right of a patent that is mandated by Art. 5. Whereas there is no exclusionary right under the Inventor's Certificate in the Soviet practice including allegations of absence of working the right, under Art. 5(4) of the Paris Convention in the case of a patent right, even if, *arguendo*, a country wanted to have national legislation to permit an immediate right of third parties to work an invention via compulsory license, this was expressly proscribed by the Paris Convention: "A compulsory license may not be applied for on the ground of failure to work or insufficient working before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last[.]" Furthermore, even outside this three to four year time window, a patentee must not have its monopoly denied via compulsory license where the patentee can justify non-working. ("[The compulsory license request] shall be refused if the

patentee justifies his inaction by legitimate reasons." *Id.*) The entire amendment dealing with the Inventor's Certificate in the Stockholm Revision as it relates to the creation of a priority right based upon such a filing is found in Art. 4(I)(1) in one single sentence: "Applications for inventor's certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents." (The only other sentence added dealing with the Soviet system is Art. 4(I)(2) that provides that "[i]n a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.").

(In the sense that an Inventor's Certificate does not comply with the requirements for a patent in terms of the exclusionary right demanded for patents by the Paris Convention, so, too, does the UPOV Convention have a variety of loopholes to permit third party use of the rights of the plant breeder that are immunized by the UPOV Treaty itself from injunctive relief under standards inconsistent with Art. 5(4) of the Paris Convention. Neither the Inventor's Certificate nor the UPOV Certificate meets the requirements of Art. 5(4) of the Paris Convention.)

### **c. Domestic Implementation of Stockholm**

The legislative history behind the domestic implementation of the Stockholm Revision clearly was to only grudgingly and in minimum fashion give users of the Soviet system their minimum rights called for by the treaty. Thus, an Inventor's Certificate was specifically added to 35 U.S.C. § 119 (now 35 U.S.C. § 119(d)) as a priority document. But, in parallel, the United States specifically broadened the forfeiture bar of 35 U.S.C. § 102(d), theretofore limited to the prior grant of a foreign counterpart patent, to *also* encompass the prior grant of an "Inventor's Certificate".

**d. UPOV — Not a Statutory "Inventor's Certificate"**

Clearly, a UPOV Certificate and an Inventor's Certificate have only one thing in common: Each is called a "Certificate". There is nothing more in common between the two instruments than this single word, "Certificate". One could just as easily say that a "Certificate of Attendance" or a "Certificate of Merit" is a forfeiture-bar creating "certificate" as each is also a "certificate" with nothing more in common than the name "certificate". Clearly, there is nothing in the legislative history that permits considering *any* "certificate" to be an "Inventor's Certificate" within the meaning of the statute.

**e. "Inventor's Certificate": Definition by the Board**

An enlarged panel of the Board has expressly declined to give expansive meaning to the "Inventor's Certificate" in yet an entirely different context. Prior to *Ex parte Fujii*, 13 USPQ2d 1073 (PTO Bd. Pat. App & Interf. 1989), it had been clear that the Japanese "Kokai" that issues for Japanese patent applications gives a right of remuneration and in that sense is parallel to the Inventor's Certificate. Fujii had filed his American application after the grant of this certificate, which the Examiner held invoked the bar of 35 U.S.C. § 102(d). Reversing, the Board said that:

The Examiner is of the view that Kokai are references under §102(d) because they "are more than mere applications, and approach invention certificates within the meaning of §102(d)." \* \* \* While a Kokai may result in certain legal consequences similar to an inventor's certificate \* \* \*, it is not in fact an inventor's certificate. See 37 CFR 1.55(b) and MPEP 201.13(a).

Because Congress saw fit to include inventor's certificates along with patents in §102(d), documents which may have similar legal consequences as inventor's certificates in the country in which they are issued do not per se rise to the level of inventor's certificates as to their legal consequences under §102(d). *Congress has not, at least as yet, seen fit to include Kokai in §102(d); it defies acceptable principles of statutory interpretation to include Kokai because of their (alleged) analogy to inventor's certificates. Cf. In re Monks*, 588 F.2d 308, 200 USPQ 129 (CCPA 1978) and *Ex parte Lander*, 223 USPQ 687 (Bd. App. 1983).

*Ex parte Fujii*, 13 USPQ2d at 1974-75 (emphasis added). In other words, the expanded panel of the Board has already held in its precedential ruling in *Fujii* that the scope of "Inventor's Certificate" is to be limited to what the *Regulations* and the *Manual* define to be an "Inventor's Certificate": The Kokai "is not in fact an inventor's certificate. See 37 CFR 1.55(b) and MPEP 201.13(a)." Thus, just as "Congress has not, at least as yet, seen fit to include Kokai in §102(d)", *Fujii*, supra, so, too, has Congress not yet seen fit to include the UPOV Certificate in § 102(d). And, just as "it defies acceptable principles of statutory interpretation to include Kokai [in § 102(d)] because of their (alleged) analogy to inventor's certificates", *id*, the same must be said for the UPOV Certificate.

## **2. PTO Practice: UPOV Plant Breeder's Rights is not a "Patent"**

### **a. The *Kaghan* Rule**

Historically, it is well settled that where there is nothing inconsistent with statute, the PTO regulations shall have the full force and effect of law. Thus, for example, where there had been a long history of judicial precedent to bar patent applicant's claims under a variety of res judicata, a statement in the *Manual* suggesting a course of action that would eliminate a res judicata rejection was found to bar such a course of action. *In re Kaghan*, 387 F.2d 398, 401 (CCPA 1967). See also *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 606 modified, 771 F.2d 480 (Fed. Cir. 1985); *Paperless Accounting, Inc. v. Bay Area Rapid Transit System*, 804 F.2d 659, 663 (Fed. Cir. 1986). The *Manual* serves to "put[ ] patent practitioners on notice \* \* \*" about issues relevant to practice before the Office. *Shulze v. Green*, 136 F. 786, 791 (Fed. Cir. 1998).

Assuming, *arguendo*, that there had been a clear statutory *mandate to require* that a UPOV certificate be considered an "inventor's certificate", this would be one matter. But where, as here, there is absolutely nothing of the kind, for the PTO to now, retroactively, disregard its own longstanding policy pronouncements and interpret an "Inventor's Certificate" as comprising a UPOV certificate clearly goes against the long administrative understanding of the statute to the contrary.

**b. What the PTO Has Said about UPOV Certificates**

The United States Patent and Trademark Office has demonstrated through both its positive pronouncements about the UPOV regime and its total silence about anything at all negative with respect to 35 U.S.C. § 102(d) that it is officially recognized by this agency that the grant of UPOV plant breeder's rights is not a "patent[ing]" within the meaning of 35 U.S.C. § 102(d).

**(i.) UPOV "does not affect [patent] examination \* \* \*"**

The PTO through its *Manual of Patent Examining Procedure* has expressly held insofar as relevant here that "[a]pplication of the UPOV Convention in the United States does not affect the examination of plant patent applications \* \* \*." MPEP § 1612. (The quoted sentence makes one exception, not relevant here, viz., "[i]t is now necessary as a condition for receiving a plant patent to register a variety name for that plant.")

**(ii.) PTO Interpretation of § 102(d) Bar**

Through its published, precedential, expanded panel opinion in *Ex parte Fujii*, 13 USPQ2d 1073 (PTO Bd. Pat. App & Interf. 1989), the PTO has given a restrictive interpretation to the meaning of an "Inventor's Certificate" for purposes of 35 U.S.C. § 102(d). Furthermore, there is not one word in the *Manual of Patent Examining Procedure* that gives a hint or suggestion that a UPOV certificate is "prior art". In searching for prior art under 35 U.S.C. § 102(d), "[t]he document *must* be a patent or inventor's certificate and not merely a published or laid open application." MPEP § 706.02(e); emphasis added. There is not one ounce of wiggle room to deny the narrow interpretation given in *Fujii* or the *Manual*.



### 3. Commonalities with the "Inventor's Certificate"

The UPOV Certificate is about as *un*-patent-like as any intellectual property right could be from the standpoint of American understanding and the international framework of the home of patents, the Paris Convention. The UPOV Certificate is not even contemplated as one of the patent or related rights within the Paris Convention, being therefore even more removed than the Inventor's Certificate which, thanks to the Stockholm Revision of the Paris Convention but unlike the UPOV Certificate, *is* within the ambit of the Paris Convention priority right.

The UPOV Certificate is the subject of a *parallel* treaty and not within the ambit of the Paris Convention. This speaks most loudly about its *un*-patent-like status in the intellectual property regime.

### 4. 1999 Priority Right Based Upon UPOV Certificates

The outstanding Official Office Action does *not* implicate the 1999 amendment to the patent law that *does* permit a priority right based upon a UPOV Certificate. Presumably, this is because there is not one word in the new legislation that in any way modifies 35 U.S.C. § 102(d). But, to be complete, this section is provided to avoid piecemeal prosecution of this issue.

To be sure, just as the United States modified its domestic law to add a priority right in 35 U.S.C. § 119 for the Inventor's Certificate, so, too, did the United States statutorily permit a priority right based upon a UPOV Certificate, which it did in the American Inventor's Protection Act of 1999, Pub. L. 106-113, via 35 U.S.C. § 119(f). But, whereas Congress simultaneously upon the domestic implementation of the Stockholm Revision expanded the forfeiture bar of 35 U.S.C. § 102(d) to encompass the Inventor's Certificate as an *alternate* bar to the prior patent grant bar, here, in the American Inventor's Protection Act of 1999, Pub. L. 106-113, Congress did not do so: It left 35 U.S.C. § 102(d) untouched.

Had Congress chosen to amend 35 U.S.C. § 102(d) to add the UPOV Certificate, clearly, it would never have done so *retroactively*: To have done so would have retroactively invalidated all the plant patents that have been granted over the past years where there has been a prior grant

of a UPOV Certificate. Clearly, the absence of any wording change in 35 U.S.C. § 102(d) speaks volumes in contrast to the parallel wording changes made in 35 U.S.C. §§ 102(d) and 119 as part of the Stockholm Revision.

**a. The Plain Meaning of the Statute**

**(i.) The Statute as the Starting Point**

The starting point is the statutory wording. *Demko v. U.S.*, 216 F.3d 1049, 1052 (Fed. Cir. 2000) (citing *Landreth Timber Co. v. Landreth*, 471 U.S. 681, 685 (1985); *Hoechst-Roussel Pharms., Inc. v. Lehman*, 109 F.3d 756, 758 (Fed. Cir. 1997)) ("Statutory interpretation begins with the language of the statute itself.") With clear statutory wording, this is the end of the matter. *Demko v. U.S.*, 216 F.3d 1049, 1052 (Fed. Cir. 2000) (quoting *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 395 (Fed. Cir. 1990) ("When the terms of a statute are unambiguous, judicial inquiry is complete, except in rare exceptional circumstances. Moreover, absent a clearly expressed legislative intention to the contrary, a statute's plain meaning must ordinarily be regarded as conclusive."))

**(ii.) Unmistakably Narrow Statutory Wording**

Where, as here, the wording of the statute is clear, this should end the matter: "If the language [of the statute] is clear, the plain meaning is conclusive." *Southwest Software, Inc. v. Harlequinn Inc.*, 2000 WL 335754 (Fed. Cir. Sept. 18, 2000) (citing *Van Wersch v. Department of Health & Human Servs.*, 179 F.3d 1148, 1152 (Fed. Cir. 1999). "Where there is no ambiguity in the words [of the statute], there is no room for construction. The case must be a strong one, indeed, which would justify a court in departing from the plain meaning of words \* \* \* in search of an intention which the words themselves did not suggest." *United States v. Wiltberger*, 5 Wheat. 76, 95-96 (1820) (Marshall, C.J.) (quoted, *U.S. v. Gonzales*, 520 U.S. 1, 8 (1997) (O'Connor, J.). See also *Meeks v. West*, 216 F.3d 1368, 1366 (Fed. Cir. 2000) ("In construing a statute \* \* \*, we begin by inspecting its language for plain meaning. See *Bazalo v.*

*West*, 150 F.3d 1380, 1382 (Fed. Cir. 1998). If the words are unambiguous, it is likely that no further inquiry is required. See *Cox v. West*, 149 F.3d 1360, 1363 (Fed. Cir. 1998).")

**b. Congress Could Have (But Didn't) Use Broader Terms**

There is no room to look to the legislative history, where, as here, the meaning of "Inventor's Certificate" is absolutely clear and free from any ambiguity insofar as it not encompassing a UPOV Certificate. Thus, courts "look first to the statutory language and then to the legislative history *if the statutory language is unclear.*" *Toibb v. Radloff*, 501 U.S. 157, 162 (1991) (quoted, *Rigsbee v. U.S.*, \_\_ F.3d \_\_, 2000 WL 1401527 (Fed. Cir. 2000) (emphasis added)).

Congress can do virtually anything it wants to in redefining patents or patent rights within the very broad Constitutional mandate of Art. I, Sec. 8, Clause 8, "to promote the progress of \* \* \* the useful arts." But, Congress in its creation of the priority right for patents and reciprocal § 102(d) forfeiture bar made only the very small, limited extension of priority rights and the reciprocal bar when it implemented Stockholm to include "Inventor's Certificates". It even more narrowly changed the patent regime when it amended 35 U.S.C. § 119 to provide a UPOV certificate priority right. Congress *could have* made a more sweeping change or *could have* reciprocally broadened the forfeiture bar of 35 U.S.C. § 102(d). *But Congress chose not to do so.* Rather, Congress said in 35 U.S.C. § 119(f), very restrictively, that "[a]pplications for plant breeder's rights \* \* \* shall have the same effect *for purposes of the right of priority under [35 U.S.C. §§ 119] (a) through (c) \* \* \*.*" (emphasis added). Thus, Congress did not say "for all purposes", or "for purposes of priority and § 102(d)", but *only* for priority purposes". Nothing more. The symmetry of the changes to both §§ 102(d) and 119 that is found *only* for the "Inventor's Certificate" represents a "statutory scheme [that] is coherent and consistent." *Robinson v. Shell Oil Co.*, 519 U.S. 337, 340 (1997) (quoted, *Rigsbee v. U.S.*, \_\_ F.3d \_\_, 2000 WL 1401527 (Fed. Cir. 2000)).

Thus, there was no indication in the statutory wording of any manifestation of any intention in any way, shape or form to modify the definition of what is or is not a "patent", and

certainly the effect was not to be implicated for anything beyond the very narrow confines of 35 U.S.C. §§ 119(a) — 119(c). Had Congress intended a more sweeping change in the law, it could have chosen to use broader language.

### **5. UPOV, A Liberalized but Parallel System**

Throughout the decade of the nineties, the President and Congress have shown a sympathy toward granting stronger UPOV rights. But, in doing so, there has never been any indication that a UPOV Certificate is in any way, shape or form being merged into a "patent".

The United States government in the enactment of a separate, parallel statutory scheme for plant patents and plant varieties has carefully drawn a line between the UPOV-type certificate protection as a separate and distinct regime from that of "patents". This is reflected in the 1991 documentation surrounding the ratification of the *Convention for the Protection of Plants*. S. Treaty Doc. No. 104-17, as read for the first time in the Senate September 5, 1995, where the President said:

I transmit herewith for Senate advice and consent to ratification the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as Revised at Geneva on November 10, 1972, on October 23, 1978, and on March 19, 1991, and signed by the United States on October 25, 1991 (hereinafter "the 1991 Act of the UPOV Convention"). I transmit for the information of the Senate, the report of the Department of State with respect to the Convention.

[The Convention] demonstrates a domestic commitment to effective protection for intellectual property in the important field of plant breeding. It is also consistent with United States foreign policy of encouraging other countries to provide adequate and effective intellectual property protection, including that for plant varieties.

I recommend, therefore, that the Senate give early and favorable consideration to the 1991 Act of the UPOV Convention and give its advice and consent to ratification subject to a reservation under Article 35(2), which allows parties to the existing Convention (the 1978 Act) *to retain their present patent systems for certain varieties of plants*.

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The concurrently reproduced *Letter of Submittal* also draws a careful line between the UPOV-style certificate protection and the existing plant patent regime:

I recommend that the 1991 Act of the UPOV Convention be transmitted to the Senate for its advice and consent to ratification, *subject to a reservation under Article 35(2) of the 1991 Act, which allows states party to the 1978 Act to retain their present patent systems for certain varieties of plants.*

\* \* \*

In the United States, implementing legislation was enacted as Public Law 103-349, on October 6, 1994.

The main aim of the Convention is to promote the protection of the rights of the breeder in new plant varieties. In that regard, the Convention not only requires member States to provide protection for new varieties of plants, but also contains explicit and detailed rules on the conditions and arrangements for granting protection. Further, it prescribes the scope of protection, including possible restrictions and exceptions thereto, establishes, with some limitations, the principle of national treatment for plant breeders from other member States, and provides for a right of priority.

\* \* \* The 1991 Act also expressly permits member States to exclude from the reach of the breeder's right, the Practice of farmers to save seed.

\* \* \*

Finally, the 1991 Act is silent regarding the title of protection under which a breeder's right may be granted. *This would afford member States the freedom to provide protection for plant varieties through patents and sui generis breeders' rights, thus affording them greater flexibility in determining how to protect new plant varieties most effectively.*

\* \* \*

I recommend, therefore, that the 1991 Act of the UPOV Convention be transmitted to the Senate as soon as possible for its advice and consent to ratification, subject to a reservation under Article 35(2), *which allows parties to the 1978 Act to retain their present plant patent systems for certain varieties of plants.*

Accompanying this letter is an —

ANALYSIS OF THE 1991 ACT OF THE INTERNATIONAL CONVENTION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

\* \* \*

Article 2 simply states that each Contracting Party "shall grant and protect breeders' rights". In that respect, the 1991 Act is silent on the form of breeders' rights to be provided and no longer contains the provision of Article 2 of the 1978 Act prohibiting a member State from providing protection by way of patents, as well as in the form of sui generis breeders' rights, for the same botanical genus or species. This improvement gives Contracting Parties the freedom to provide either, or both, types of protection for plant varieties.

\* \* \*

*Article 6 defines that novelty under this Convention refers to the prior commercialization of the variety, rather than novelty in the sense of patent law.*

\* \* \*

\* \* \*

Article 11 regulates the right of priority that may be claimed in an application filed in one Contracting Party on the basis of an earlier application filed in another Contracting Party. The provisions of Article 11 differ from those of Article 12 of the 1978 Act, in that the 1991 Act is more specific in permitting the claim of priority only to be made in an application for a breeder's right, *although the basis for such claim may be an application for the protection of a variety, including a patent application.*

\* \* \*

Article 14(5) clarifies that the scope of protection of the breeder's right extends also to varieties (1) that are not clearly distinguishable from the *patented variety*, (2) to varieties whose production requires the repeated use of the protected variety, and, most importantly, (3) to varieties that were essentially derived from the protected variety.

\* \* \*

Article 35 provides for the possibility of a reservation to the 1991 Act of the Convention only by a State that is a party to the Act of 1978 and that provides protection for asexually reproduced varieties by means other than a breeder's right. Upon notifying the Secretary-General at the time of depositing its instrument of ratification, such State is permitted to continue protection of asexually reproduced varieties without applying the obligations and requirements of the 1991 Act to these varieties. *This reservation is specifically intended to permit the United States to continue its present system of providing protection for asexually reproduced varieties by way of plant patents under sections 161 et seq. of title 35, United States Code, rather than plant breeders' certificates under section 2321 et seq. of title 7, United States Code.* A similar,

but less comprehensive reservation is already contained in Article 37 of the 1978 Act of the Convention.

While the 1991 treaty opens the door for stronger rights closer to the patent regime than the original laws under UPOV, what was important for foreign countries outside the United States was that on a state by state basis each UPOV state has the right to totally deny any monopoly rights. Article 15(1) ("Exceptions to the Breeder's Right") excludes various private and experimental acts. Article 15(2) is an "optional exception" that on a state by state basis may provide:

within reasonable limits and subject to the safeguarding of the legitimate interests of the breeder, restrict[ion to] the breeder's right in relation to any variety in order to permit farmers to use for propagating purposes, on their own holdings, the product of the harvest which they have obtained by planting, on their own holdings, the protected variety or a variety covered by Article 14(5)(a)(i) or (ii).

In addition to a provision for exhaustion of the breeder's right (Article 16), each state is free to totally eliminate any monopoly right whatsoever: "Except where expressly provided in this Convention, no Contracting Party may restrict the free exercise of a breeder's right for reasons other than of public interest." Then, there is only a right to "equitable remuneration": When any such restriction has the effect of authorizing a third party to perform any act for which the breeder's authorization is required, the Contracting Party concerned shall take all measures necessary to ensure that the breeder receives equitable remuneration." Article 17(2) (Restrictions on the Exercise of the Breeder's Right).

#### **6. Law Controlling UPOV Certificates Does Not Equate UPOV Certificates with Inventor's Certificates**

The Official Office Action says nothing about the specific laws implicated in the 35 USC § 102(d) rejection, and how it does or does not mirror the Soviet model, the "Inventor's Certificate". Clearly, the burden is upon the PTO to establish that the relevant law meets the

footprint of an "Inventor's Certificate" if it is to maintain a rejection that is tantamount to saying that, here, a Plant Breeder's Certificate is an "Inventor's Certificate".

The Dutch Plant Breeder's Right, for example, is just as un-patent-like, *supra* at subsection 3. Thus, the Dutch Plant Breeder's Right is as far removed from an Inventor's Certificate as the UPOV Certificate. The un-patent-like nature of the Dutch Plant Breeder's Right is revealed by the following considerations of the pertinent Dutch law. First, the Dutch, as a member State of the European Patent Convention, do not consider plant varieties as statutory subject matter. Article 53(b) of the European Patent Convention states:

European patents shall not be granted in respect of:

(b) plant or animal varieties or essentially biological processes for the production of plants or animals....

While Dutch law allows no variety of plant to be patented, the Dutch Seeds and Planting Material Act (October 6, 1966, as amended May 2, 1984), which prescribes *inter alia* the rights protected by plant breeder's rights, provides that, "[a] plant breeder's right may be granted in respect of a new variety of a plant genus or species." Section 29. Thus, Dutch law clearly distinguishes between patent protection and plant breeder's rights as vehicles to protect rights to plant varieties.

Second, Dutch law compels breeders to license on terms that may be determined by a Board of Plant Breeders' Rights ("Board"). This is evident from the following sections of the Dutch Seeds and Planting Material Act:

**Section 42**

1. The holder of a plant breeder's right shall grant such licenses as are necessary to the public interest.
2. The obligation referred to in the preceding paragraph shall include the obligation of the holder of a plant breeder's right to furnish the licensee at a reasonable price with the propagating material he needs if he is to make proper use of the license.



**Section 43**

1. If the holder of a plant breeder's right does not fulfil the obligation referred to in Section 42, the license shall be granted by the Board if interested parties so request. Section 36 (plant breeder entitled to fair remuneration) shall apply *mutatis mutandis* with respect to the request.
2. Before taking a decision the Board shall give the parties an opportunity to reach agreement within a period determined by the Board.
3. If agreement cannot be reached the Board shall decide after having heard the parties. The scope of the license, the remuneration to be paid to the holder of the plant breeder's right, and the quantity of propagating material to be furnished and the remuneration to be paid for it shall be fixed in the decision. When taking a decision the Board may require the person who has obtained the license to furnish security within a certain period.
4. When the Board has granted the license and the obligation to provide security, if imposed, has been complied with, the license shall be entered in the Netherlands Register of Varieties. The license shall not operate until the date of its entry. From that date it shall also operate as regards persons who acquired rights on the plant breeder's right after the date of the publication referred to in paragraph (1).

Dutch law thus compels the plant breeder to license (Section 42[1]) and at a "reasonable price" (Section 42[2]), which may be determined by the Board (Section 43[1]). Of course, the holder of a United States patent is under no similar obligation to license his product. Consistent with Article 17 of the UPOV Convention, *supra*, The Dutch restrict monopoly rights in a manner incongruent with those rights afforded by a patent.

**7. Conclusion**

Wherefore, it is manifest that a UPOV certificate or plant breeder's right for any of the countries of that treaty is not considered to be an "Inventor's Certificate" within the meaning of 35 U.S.C. § 102(d). Accordingly, the rejection should be withdrawn.

Applicant will subsequently file a substitute executed Declaration and Power of Attorney in response to the Official Action and in compliance with 37 CFR 1.162.

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Additionally, the description of the claimed variety contained in the instant application has been reviewed for completeness and accuracy.

Accordingly, it is respectfully urged that the examiner's objection to the disclosure and rejection of the claim should be withdrawn.

In view of the foregoing amendments and remarks, the application is believed in condition for immediate allowance, and such action is earnestly solicited. In the event any minor matters remain, the examiner is requested to contact the undersigned attorney of record at the telephone number appearing below so that allowance of the application can be expedited.

Respectfully submitted,

January 4, 2008  
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